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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	91211873
Party	Plaintiff Green Ivy Educational Consulting, LLC
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Attachments	2014 08 07 GIEC SJ Reply Brief.pdf(1124890 bytes )



to the filing date of GIH's applications. Applicant does not contest that the dominant portion of each of its own marks is also GREEN IVY, which it intends to use in connection with educational services. The overlap between GIEC's acknowledged "school consultant[cy]" services and Applicant's own "curriculum development," as well as between GIEC's acknowledged "tutoring" and Applicant's instructional and "after school educational and enrichment programs" (not to mention GIEC's educational product review services and Applicant's educational product review and certification program) is clear, as are the fact that these services – which are not restricted by GIH – are likely to travel in the same channels of trade and be marketed to the same audience of parents and school administrators. As a result, the likelihood of confusion here is plain, and granting registration to the Marks Under Application would be improper. Summary judgment should be granted for Opposer.

### FACTS

Applicant attempts to distract from the clear evidence in the record with respect to the material issues in this case, but the written and depositional testimony establish that:

- The GIEC name, which includes GREEN IVY, was selected in late 2003 and put into use by Opposer in March 2004. Homayoun Dep. Tr. 81:12-18; see also Homayoun Decl. ¶ 8. This is over eight years prior to the filing of the Applications at issue here.
- In March 2004, GIEC began using both GREEN IVY and GREEN IVY EDUCATIONAL CONSULTING in its work with "elementary and secondary school students during school hours and after school to provide tutoring and learning support services...." Homayoun Decl. ¶¶ 8-9; see also, e.g., Barsky Declaration Exhibit A ("Homayoun Dep. Tr.") 23:22-24; 37:2-12 (July 23, 2014).
- GIEC has since expanded the services offered under the Marks to include, for example, school consulting, workshops, and an e-newsletter. See, e.g., Homayoun Decl. ¶¶ 8-17; see also, e.g., Homayoun Dep. Tr. 21:24-22:22.

## ARGUMENT

### I. SUMMARY JUDGMENT IS APPROPRIATELY GRANTED

#### A. There Are No Disputed Material Issues of Fact

Regardless of GIH's protestations, there is simply no basis to dispute the facts in the record regarding the material issues in this case. GIH attempts to distract the Board from these material issues by making much of purported evidentiary disputes regarding certain exhibits to the Homayoun Declaration.<sup>3</sup> However GIH does not dispute GIEC's characterization of Applicant's "educational services" or Ms. Homayoun's description as to the services provided by GIEC – namely the provision of educational services including tutoring, workshops, and consulting services – nor does GIH even attempt to dispute the evidence submitted regarding the identical nature of the channels in which those services are provided. See, e.g., Applicant's Response in Opposition to Opposer's Motion for Sanctions and For Summary Judgment ("Opp.") Sect. III(e) (July 23, 2014) (acknowledging evidence shows GIEC provides tutoring and consulting services). GIH also submits with its opposition Ms. Homayoun's deposition transcript, which provides even further evidence in support of, inter alia, GIEC's date of first use and the services it provides under the Mark. See generally, Homayoun Dep. Tr..

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<sup>3</sup> GIH disputes Ms. Homayoun's ability to present admissible evidence in her Declaration, however, Ms. Homayoun states in the very first paragraph that she is "the Founder and Director of Green Ivy Educational Consulting, LLC" and that the "facts herein are true to my own knowledge" unless set forth upon information and belief. Homayoun Decl. ¶ 1. Applicant makes no challenge to any of the material facts in issue here on these grounds, nor can it, as it is clear from the face of the Declaration that Ms. Homayoun has personal knowledge of these facts based on her role as the founder of GIEC. Moreover, Applicant makes much of Homayoun's purported failure to set out whether she makes the declaration in either her personal or corporate capacity, but does not cite any rule requiring such a distinction to be made (nor is there one). Just as Jennifer Jones provided testimony informed by her knowledge as the founder of GIH, Ms. Homayoun has similarly provided testimony as the founder of GIEC. Though GIH engages in substantial hand-waving regarding the appearance of Ms. Homayoun's name on many of the documents submitted, it in large part does not dispute that the Mark also appears on those documents. The exhibits have been submitted simply as examples in addition to the sworn testimony of Ms. Homayoun, which is on its own sufficient for a grant of summary judgment.

**B. Opposer has Standing to Challenge Registration of Applicant's Marks**

Applicant's half-hearted argument that it is "unclear" whether Opposer lacks standing should be rejected out of hand, as the entirety of this argument is based on Applicant's purported confusion as to whether Opposer owns GREEN IVY or GREEN IVY EDUCATIONAL CONSULTING. Opp. Sect. I. Yet Opposer made clear in its initial motion for summary judgment that GIEC has been using both GREEN IVY and GREEN IVY EDUCATIONAL CONSULTING since it adopted the marks in March 2004: GREEN IVY EDUCATIONAL CONSULTING is Opposer's trade name and mark, and GIEC also uses the mark GREEN IVY "to signify that a product or service originates with GIEC – GREEN IVY is GIEC's brand, which appears on, for example, GIEC's website, written products, presentation materials, and advertisements...." Homayoun Decl. ¶ 8; see also Homayoun Dep. Tr. 82:1-6 ("Green Ivy is the main mark that's known. Educational consulting is simply a descriptor. Students will say I go to Green Ivy."). Regardless, GREEN IVY is clearly the dominant portion of GREEN IVY EDUCATIONAL CONSULTING, and thus the portion of GREEN IVY EDUCATIONAL CONSULTING that is enforceable as against attempted future users like GIH, which now seeks to register not only the mark GREEN IVY, but two related marks with similar use of GREEN IVY coupled with descriptive educational words. See Mem. 15-16, n.9 (collecting cases). Applicant cannot seriously question the standing demonstrated by Opposer in its motion. Mem. 1.

**C. Opposer is the Undisputed Senior User and Sole Owner of the Green Ivy Mark**

Applicant's unsupported insistence that Opposer's status as senior user has not been established is clearly refuted by the record. First, the Homayoun Declaration states that GIEC has been using both GREEN IVY and GREEN IVY EDUCATIONAL CONSULTING since March 2004 in its work with "elementary and secondary school students during school hours and after

school to provide tutoring and learning support services” and has since expanded the services offered under the Marks to include, for example, school consulting, workshops, and an e-newsletter. See, e.g., Homayoun Decl. ¶¶ 8-17. Second, Ms. Homayoun testified that she decided on the GIEC name in late 2003, and began using it in March 2004. Homayoun Dep. Tr. 81:12-18. Thus the only evidence in the record in fact demonstrates that Opposer’s use of the mark GREEN IVY – either as the dominant portion of GREEN IVY EDUCATIONAL CONSULTING or independently – predates Applicant’s attempt to register its three GREEN IVY marks by at least eight years.<sup>4</sup> See also Mem. 12-13.

**D. A Likelihood of Confusion Clearly Exists Between Opposer’s GREEN IVY Mark and the Marks Under Application**

GIH does not contest that GIEC has set forth the relevant factors under In re E.I. DuPont de Nemours & Co., 476 F.2d at 1361. However GIH does not address all the factors in its opposition and fails to establish that those it does address do not weigh in favor of Opposer.

**1. GIEC’s Mark Is Strong**

GIH argues that GIEC’s GREEN IVY mark is weak because there is no evidence of sales volume. However GIH completely ignores the relevant conceptual strength of the mark, which is thus admitted. See Mem. 14.

Though GIH attempts to distinguish Ms. Homayoun from Opposer, she is in fact the founder and public face of GIEC.<sup>5</sup> Consumers contact her through GIEC and, as she testified, she uses the mark on materials she distributes and references the mark and services provided under it

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<sup>4</sup> GIH does not even attempt to contest the further evidence submitted that GIEC has “promoted its services by using the GREEN IVY mark on its website, [www.greenivyed.com](http://www.greenivyed.com), as well as through emails to its email list” since 2006 and “through social media including Facebook and Twitter” since 2009. Mem. 3 (citing Homayoun Decl. at ¶¶ 23-24, 16-18). Yet all of these uses also predate the Applications by several years.

<sup>5</sup> Ms. Homayoun is not the only employee of GIEC, however. As she testified, there are approximately eight other employees that work with Ms. Homayoun to provide services under the Mark, including through work on “curriculum development, they work with students, they help [her] prepare for talks. They do a wide range of activities.” Homayoun Dep. Tr. 6:15-23.

at speaking engagements. See, e.g., Homayoun Decl. ¶ 19; Homayoun Dep. Tr. 84:25-86:1 (testifying that her practice is to deposit any checks received in her own name for speaking engagements in the GIEC bank account, and that she hands out materials with the GREEN IVY mark at speaking engagements). These engagements, as well as media attention to GIEC and Ms. Homayoun as GIEC's founder, further the national reputation of GIEC's GREEN IVY mark and draw clients to GIEC. See, e.g., Homayoun Decl. ¶ 27 (after press coverage in the New York Times, GIEC received a significant increase in requests for its services from a national and international audience). Thus there has been clear public exposure to the mark over a period of several years, including media attention outlined in GIEC's moving papers. See, e.g., Mem. 3-4, 14-15. The fact that Ms. Homayoun has been the public face of GIEC in no way detracts from that clear fact.

## **2. Similarity of the Marks**

GIH does not contest, nor could it, that this factor favors GIEC. The dominant element of all of the marks at issue in the case is clearly "GREEN IVY."

## **3. The Goods and Services Are Closely Related**

GIH provides no legal support for its theory that GIEC must provide "evidence" of the "overlap" between the services, despite its acknowledgement that a determination of likelihood of confusion must be based on an analysis of the services recited in Applicant's applications in contrast to those shown to be in use by Opposer. Opp. 11.

Indeed the services of the parties need not "overlap" to support a holding of likelihood of confusion. Rather, "it is sufficient that the respective goods of the parties be related in some manner, and/or that the conditions and activities surrounding the marketing of the goods are such that they would or could be encountered by the same persons under circumstances that could, because of the similarity of the marks, give rise to the mistaken belief that they originate from

the same source.” See Hilson Research, Inc. v. Society for Human Resource Mgmt., 27 U.S.P.Q. 2d 1423 (TTAB 1993) (citation omitted); In re Int’l Telephone & Telegraph Corp., 197 U.S.P.Q. 910 (TTAB 1978). Specific evidence of a defined overlap is not necessary to support a finding that the educational services are at least “related.”

Yet such evidence is abundant here, as set out in detail in Opposer’s opening memorandum. Mem. 17-20. Applicant acknowledges that it is “undisputed” that “Applicant seeks registration for:

Educational services, namely, providing pre-kindergarten through 12<sup>th</sup> grade school instruction, *curriculum development*, education administration and operation, *before and after school educational and enrichment programs*, school break programs; live and online education, as well as *providing, reviewing and certifying educational and parent material including software, toys, books, classroom materials and lesson plans*.

Opp. Sect. III(e) (emphasis added, citation omitted). And GIH’s own founder, Jennifer Jones, explained that GIH will “develop[] curriculum for others” by, for example, working with “an entity that wants to develop a new school and they seek us out for help with developing a curriculum because they like what we’re doing in one of our own schools, we would offer that service.” Jones Dep. Tr. 39:19-40:17 (describing service as a “consulting” service).

With respect to GIEC’s services, even in its opposition GIH admits that GIEC similarly provides “consultant” services – akin to Applicant’s “curriculum development” – as it must given the evidence in the record. Opp. Sect. III(e); see also, e.g., Homayoun Decl. ¶¶ 11, 14, 22 (discussing GIEC’s consulting services); Homayoun Dep. Tr. 22:7-11 (“We perform curriculum development in schools, so schools hire us, and we help them with organization, time management and a wide range of curriculum development”); see also McArdle Decl. Ex. A (GIEC Application). It is also clear that Opposer GIEC offers other “educational services” under the Mark, including what Applicant appears to characterize as “tutoring” (academic coaching



and workshops and seminars on topics relating to education), which are related or comparable to Applicant's instructional and "before and after school educational and enrichment programs." Homayoun Decl. ¶¶ 8-21; Homayoun Dep. Tr. 23:22-24; 37:2-12; 77:16-23; see also McArdle Decl. Ex. A (GIEC Application). The record also shows that GIEC offers educational product development and distributes an email newsletter as a resource for parents in connection with other educational goods and services, including the review of educational products and services. Homayoun Decl. ¶¶ 8-21; Homayoun Dep. Tr. 41:8-19; see also McArdle Decl. Ex. A (GIEC Application). Once again, these services are clearly related or comparable to Applicant's services, namely "providing, reviewing and certifying educational and parent material." Applicant offers no meaningful basis to differentiate any of the services offered by GIEC, which are clearly related to those listed in GIH's Application.

**4. Other Factors to Consider**

**a. The Services Will Be Marketed in Identical Channels**

By failing to address this factor at all, GIH has admitted that the services will travel in the same channels and that this factor weighs strongly in favor of GIEC.

**b. In Just a Short Time, There Has Already Been Substantial Actual Confusion**

Applicant attempts to trivialize the evidence submitted in connection with Opposer's points on actual confusion, yet GIH has only been offering its services for less than a year and has not yet begun to offer the full scope of its intended services, and there have already been several instances of actual confusion as to the origin of services offered by GIH and GIEC under the GREEN IVY mark. See Mem. 22-24. Especially given Applicant's gross failure to provide meaningful discovery in this matter, see Mem. 5-10, that there have already been this many

instances of confusion is remarkable, and this factor thus also weighs strongly in favor of refusing the Applications.

**c. Applicant Did No Trademark Searching – or Even a Search via Google – In an Effort to Determine Whether There was a Prior Existing User Before Filing the Applications**


GIH also does not contest that it did no searching and made no effort whatsoever to avoid a senior user. Even beyond this admission, all doubts should be resolved in favor of the senior user against the newcomer.

Taken as a whole, the factors on which there is evidence weigh strongly in favor of a finding of likelihood of confusion. The Applications should therefore be refused.

**CONCLUSION**

For the foregoing reasons, based on the undisputed facts, there is a likelihood of confusion between the senior user and the proposed registrant, such that it is appropriate to enter summary judgment on behalf of Opposer herein, and deny the applications of Applicant GIH.

Dated: August 7, 2014  
New York, New York



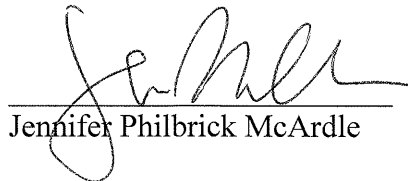
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**CERTIFICATE OF SERVICE**  
(37 C.F.R. § 2.119)

I declare under penalty of perjury that on the 7th day of August, 2014, OPPOSER'S REPLY IN FURTHER SUPPORT OF ITS MOTION FOR SUMMARY JUDGMENT was served on applicant, GREEN IVY HOLDINGS LLC, by delivering a true and correct copy, by First Class Mail, postage prepaid, to:

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